RESPONSE

Remarks

Claims 1 and 4 have been amended. Claims 1 - 6 are pending.

Examination and reconsideration of the application as amended is requested.

Support for amended claim 1 can be found at page 9, lines 2 - 29 and Figures 1 - 3.

Rejections under 35 U.S.C. § 112

Claims 1 - 6 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 1 has been amended to clarify the positioning of the "layer of an electrically conductive coating" and the "layer comprising . . . adhesive."

Claim 4 has been amended to correct "(poly-3,4-ethylenedioxy)thiophene" to --poly(3,4-ethylenedioxy-thiophene)--.

In summary, Applicants submit that rejection of claims 1 - 6 under 35 U.S.C. § 112, second paragraph, has been overcome, and the rejection should be withdrawn.

Rejections under 35 U.S.C. §103

The Office Action indicated rejection of claims 1 - 6 under 35 U.S.C. § 103(a) as being unpatentable over Lin (U.S. 6,027,802). in view of Abe et al (U.S. 6,017,610).

M.P.E.P. §2142 places the burden on an examiner to factually support any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. Specific conditions, presented in M.P.E.P. §706.02(j), require that an Office action set forth:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate.

(B) the difference or differences in the claim over the applied reference(s).

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The Office action satisfies requirements A and B but is unclear regarding how to modify the reference or offering explanation concerning motivation of one skilled in the art at the time

the invention was made to modify the reference to produce an adhesive cover tape as claimed by the present invention.

According to M.P.E.P. 2142, if the Office action includes a flawed *prima facie* case of obviousness, the applicant is free from obligation to submit evidence of nonobviousness. A further deficiency of the Office action is the omission of evidence showing how the prior art reference teaches or suggests all the claim limitations.

According to the Office Action, in rejection of claims 1 - 6 of the present invention:

"Lin's invention is directed to a cover tape for use with a carrier tape (column 1, lines 5 - 6). In Fig. 4, Lin teaches a cover tape comprising a substrate layer (12), selected from a group of biaxially extended polyester film, polypropylene film, etc., and a release coating layer (11). At an opposite side of the substrate layer (12), there are provided with an adhesive layer (13) and a non-adhesive layer (14) over the adhesive layer (13). The non-adhesive layer (14) has one side adhered to the adhesive layer (13), and an opposite side having a layer of antistatic coating (column 6, lines 4 - 25). Additionally, in Figs. 1 - 3, Lin shows various alternative structures of prior art cover tapes. Lin also teaches that antistatic coating can be a coating of intrinsically conductive polymer, such as polyaniline (column 6, lines 29 - 35).

The Office Action contains admission that:

"For claims 1, 3, 5 and 6, it is noted that Lin lacks the specific teachings of the composition of the conductive coating, the degree of clarity of the tape, and the surface resistance of the tape.

This statement is disregarded as follows:

"However, it is believed that it is well known that polythiophene or polyaniline are suitable for making transparent conductive coatings. Alternatively, Abe's invention is directed to a conductive laminate made from polyester substrate (column 1, lines 12 - 24). Examples of conductive polymers include water dispersed polyaniline (column 3, line 67 to column 4, line 7). Abe also discloses that the conductive laminate has a high transparency, and its surface resistance at 25°C, under 15% RH atmospheres is in the range of 10^6 - 10^{12} Ohm (column 10, lines 25 - 34). It should be noted that the polymer backbones of polythiophene and polyaniline are inherently conjugated.

The Office Action further admits omission from the references based upon the statement:

"Although Abe is silent about the clarity of the conductive coating, it is believed that since the scope of Abe's invention is essentially the same as the instant claimed invention, the degree of clarity of the tape laminate is either inherently disclosed or an obvious optimization. As such, it would have been obvious to one of ordinary skill in the art to modify the conductive coating of Lin's cover tape with Abe's conductive coating composition, motivated by the desire to make a cover tape, which has good transparency and conductivity as taught by Abe.

Amendment of claim 1 clarifies the positioning of antistatic material and adhesive edge strips as disposed on the same major surface of the polyester substrate of the cover tape according to the present invention. This arrangement of antistatic layer and adhesive layer is not taught by the combination of references of Lin and Abe et al. In fact the references teach away from the present invention since Abe et al show no preference regarding application of a conductive layer to a substrate and Lin directs, at column 6, lines 26 - 35, that "In order to prevent static charge impact damage imposed on the packed components, the exterior surface of

the cover layer (11) may be coated with either an antistatic agent or charge dissipation media or the like." Contrary to cover tapes according to amended claim 1 of the present invention the combined teaching of Lin and Abe would place the electrically conductive coating on the opposite side of the substrate to the layer of pressure sensitive adhesive composition.

MPEP 706.02(j) requires that the prior art references when combined must teach or suggest all the claim limitations. The Office action admits that the references of both Lin and Abe et al are silent concerning the degree of clarity of either the tape or conductive coating. Further it has been shown that one of ordinary skill in the art at the time the invention was made, following the combined teachings of Lin and Abe et al, would be motivated to produce a laminate having adhesive portions on one side and conductive portions on the other, contrary to the present invention.

The rejection of claims 1 - 6 under 35 U.S.C. § 103 as being unpatentable over Lin in view of Abe et al has been overcome and should be withdrawn.

Claim 4 adds additional limitations to claim 1. Claim 1 is patentable for the reasons given above. Thus, claim 4 should likewise be patentable.

The prior art made of record does not appear to teach either tapes having adhesive edge portions or cover tape structures having a conductive layer between edge layers of pressure sensitive adhesive.

Applicants have made an earnest attempt to respond to each point made by the Examiner. Based on the foregoing reasons, it is submitted that the application is in condition for allowance. Request is respectfully made for reconsideration of the application and allowance of amended claim 1 and claims 2 - 6 dependent therefrom.

Please charge Deposit Account 13-3723 any amounts due and owing by reason of this response. For further questions, please contact Applicant's agent who may be reached at telephone number (512) 984-5258.

Respectfully submitted,

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Version With Markings to Show Changes Made

Please amend claims 1 and 4 as follows:

1. (amended) A pressure sensitive adhesive cover tape comprising a polyester substrate having at least one major surface including a longitudinal section between a first edge strip and a second edge strip said at least one major surface supporting [coated] on at least a portion thereof [of at least one major surface thereof]:

a) a layer of an electrically conductive coating disposed in said longitudinal section, said electrically conductive coating comprising a dispersion of a conductive polymer selected from the group consisting of polythiophenes and polyanilines, said polymer having a conjugated polymer backbone, said dispersion containing at least one polymeric polyanion compounds, and at least one binder, and

b) a layer comprising a polymeric pressure-sensitive adhesive composition, positioned at each of said first edge strip and said second edge strip, said cover tape having a degree of clarity of from about 80% to about 99%, and a surface resistance of from about 1 x 10^4 Ohm to about 1 x 10^{12} Ohm.

4. (amended) A pressure-sensitive cover tape according to claim 1, wherein said polythiophene dispersion comprises [(] poly(3,4-ethylenedioxy[])]-thiophene).